UNITED STATES PATENT AND TRADEMARK OFFICE

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10/567,677	02/09/2006	Louis Robert Litwin	PU030178	2862

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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/567,677	LITWIN, LOUIS ROBERT
	Examiner	Art Unit
	TOAN D. NGUYEN	2472

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>Amendment 01/20/11</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-20</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>09 February 2006</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some * c)☐ None of:

         1.☐ Certified copies of the priority documents have been received.

         2.☐ Certified copies of the priority documents have been received in Application No. _____ .

         3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ .

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments filed 01/20/11 have been fully considered but they are not

persuasive.

The applicant argues on page 8, second paragraph with respect to claims 1, 7,

and 13 that none of the cited portion of Hussa disclose that a user is provided,

responsive to receiving over said wireless network said location of said wireless local

area network (WLAN), with a menu option selection for selecting a distance or distance

range from a wireless service area of the wireless network to said location of said

wireless local area network (WLAN) because the selection criteria used by the approach

of Hussa is always predetermined criteria (i.e., predetermined before receiving any

access point locations). The applicant argues further that predetermined selection

criteria used by Hussa (paragraphs [0010], [0011], [0012], [0032]) is either (pre) fixed

(i.e., before the specific request for service, namely of an access point location) or may

be provided by the user in connection with the (initial) request for WLAN location

service, and such selection criteria is provided to the user of the approach of Hussa

before any location information of the WLAN is received by such user, in direct contrast

to the explicit limitations recited in claims 1, 7, and 13. The examiner disagrees. Hussa

clearly teaches at paragraph [0038], lines 3-13 in the following passage: "In network-

based positioning, the terminal sends a service request to the network. In response, the

network computes the location estimate of the terminal (a distance or distance range as

the selection criteria means) and sends the location estimate to the terminal. At the

terminal, the access point set is selected based on the WLAN coordinates (selecting a distance or distance range means), and these coordinates may be downloaded from the network or the network sent (providing means) the terminal the coordinates the access points within a given maximum distance from the terminal."

The applicant argues on page 10, first paragraph that Hussa fails to include even one occurrence of the word "menu". The examiner disagrees. Hussa teaches that the access point is selected at the terminal, and the terminal includes a display unit 512 for displaying the locations of the access points for the user (menu option selection means)(paragraph [0042], lines 21-23).

The applicant argues on page 11, second paragraph that a user at the mobile terminal as per claims 1, 7, and 13 specifically tailor search results to a particular distance or distance range upon receiving the location of the WLAN. The examiner disagrees. The examiner can not find "specifically tailor search results to a particular distance or distance range upon receiving the location of the WLAN" limitation any where in claims 1, 7, and 13.

The applicant argues on page 11, fourth paragraph that the failure of an asserted combination to teach or suggest each and every feature of a claim remain fatal to an obviousness rejection under 35 U.S.C. § 103. In response to applicant's argument that there is no teaching, suggestion, or motivation to combine the references, the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves

or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In this case, the motivation to combine Hussa's teaching of network-based positioning in H. Gray would be to send the terminal the coordinates of the access points within a given maximum distance from the terminal for H. Gray's request positions and/or direction to one or more nearby WLANs.

The applicant argues on page 12, second and third paragraphs, that claims 1, 7, and 13 are patentably distinct and non-obvious over the cited references. Claims 2-6 and 19 are patentably distinct and non-obvious over the cited references for at least the reasons set forth above with respect to independent claim 1, claims 8-12 are patentably distinct and non-obvious over the cited references for at least the reasons set forth above with respect to independent claim 7, and claims 14-18 and 20 are patentably distinct and non-obvious over the cited references for at least the reasons set forth above with respect to independent claim 13. The examiner disagrees. Claims 1, 7, and 13 are rejected. Therefore, claims 2-6 and 19 are rejected with respect to independent claim 1, claims 8-12 are rejected with respect to independent claim 7, and claims 14-18 and 20 are rejected with respect to independent claim 13.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over H. Gray (US 2004/0203873) in view of Shaheen et al. (US 7,047,036) further in view of Hussa US 2004/0156372).

For claim 1, H. Gray discloses method and system of informing WAN user of nearby WLAN access point, comprising:

transmitting a user request to a wireless service provider of a wireless network for a location of a wireless local area network (WLAN)(figure 5, page 4, paragraph [0035], lines 2-4); and

receiving from said wireless service provider said location of said wireless local area network (WLAN)(figure 5, reference step 6, page 4, paragraph [0039], lines 1-4).

However, H. Gray does not expressly disclose a user initiated request for a location of a wireless local area network (WLAN). In an analogous art, Shaheen et al. discloses a user initiated request for a location of a wireless local area network (WLAN)(col. 2, lines 32-35).

One skilled in the art would have recognized the user initiated request for a location of a wireless local area network (WLAN), and would have applied Shaheen et al.'s initiates acquisition of the locations of the preferred WLANs in H. Gray's request positions and/or direction to one or more nearby WLANs. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to use Shaheen et al.'s method and apparatus for handoff between a wireless local area network (WLAN) and a universal mobile telecommunication system (UMTS) in H. Gray's method and

system of informing WAN user of nearby WLAN access point with the motivation being

to provide the locations of the preferred WLANs (col. 2, lines 34-35).

Furthermore, H. Gray in view of Shaheen et al. does not expressly disclose

providing, responsive to said receiving step, a user with a menu option selection in a

mobile device for selecting a distance or distance range from a wireless service area of

the wireless network to said location of said wireless local area network (WLAN). In an

analogous art, Hussa discloses providing, responsive to said receiving step, a user with

a menu option selection in a mobile device for selecting a distance or distance range

from a wireless service area of the wireless network to said location of said wireless

local area network (WLAN)(In network-based positioning, the terminal sends a service

request to the network. In response, the network computes the location estimate of the

terminal and sends it to the terminal. At the terminal, the access point set is selected

based on the WLAN coordinates, and these coordinates may be downloaded from the

network or the network sent the terminal the coordinates the access points within a

given maximum distance from the terminal, paragraph [0038], lines 3-13), and a

terminal includes a display unit 512 for displaying the locations of the access points for

the user (menu option selection means), paragraph [0042], lines 21-23).

One skilled in the art would have recognized the providing, responsive to said

receiving step, a user with a menu option selection in a mobile device for selecting a

distance or distance range from a wireless service area of the wireless network to said

location of said wireless local area network (WLAN), and would have applied Hussa's

service request in H. Gray's request positions and/or direction to one or more nearby

WLANs. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to use Hussa's access point service for mobile users in H. Gray's method and system of informing WAN user of nearby WLAN access point with the motivation being selected the access point set based on the WLAN coordinates paragraph [0038], lines 8-9).

For claim 2, H. Gray discloses further comprising after said step of transmitting said wireless service provider determining a wireless service area from which said transmitting originated (page 4, paragraph [0037], lines 1-16).

For claim 3, H. Gray discloses further comprising after said step of determining said wireless service provider obtaining said location of said wireless local area network WLAN based on said wireless service area (page 4, paragraph [0038], lines 2-9).

For claim 4, H. Gray discloses wherein said wireless network is a cellular telephone network (figure1, reference 10, page 2, paragraph [0020], line 1).

For claims 5, 9, and 20, H. Gray discloses wherein requesting a location of a wireless local area network WLAN relative to a specific location (page 4, paragraph [0035], lines 2-4).

H. Gray discloses wherein said controller processes said user request for said location of said wireless local area network WLAN based on a user provided location (page 4, paragraph [0040], lines 9-20 as set forth in claim 9); and wherein the user request for the location of the wireless local area network (WLAN) is transmitted by the mobile device when the mobile device is within the wireless service area (page 4, paragraph [0035], lines 2-4 as set forth in claim 20).

However, H. Gray does not expressly disclose said user initiated request for a location of a wireless local area network (WLAN). In an analogous art, Shaheen et al. discloses said user initiated request for a location of a wireless local area network (WLAN)(col. 2, lines 32-35).

Shaheen et al. discloses said user initiated for said location of said wireless local area network WLAN (col. 2, lines 32-35 as set forth in claim 9); and the user initiated for said location of said wireless local area network WLAN (col. 2, lines 32-35 as set forth in claim 20).

One skilled in the art would have recognized the user initiated request for a location of a wireless local area network (WLAN), and would have applied Shaheen et al.'s initiates acquisition of the locations of the preferred WLANs in H. Gray's request positions and/or direction to one or more nearby WLANs. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to use Shaheen et al.'s method and apparatus for handoff between a wireless local area network (WLAN) and a universal mobile telecommunication system (UMTS) in H. Gray's method and system of informing WAN user of nearby WLAN access point with the motivation being to provide the locations of the preferred WLANs (col. 2, lines 34-35).

For claim 6, H. Gray discloses wherein said location of said wireless local area network WLAN comprises one of a street address, a map location, longitude and latitude coordinates, and global positioning coordinates (page 5, paragraph [0043], lines 6-8).

For claim 7, H. Gray discloses method and system of informing WAN user of nearby WLAN access point, comprising:

a wireless transceiver for transmitting and receiving communication over a wireless network (figure 6, references 183 and 186, page 4, paragraph [0041], lines 12-13); and

a controller for processing a user request from a user of the apparatus over said wireless network for a location of a wireless local area network WLAN and processing receiving over said wireless network said location of said wireless local area network WLAN (figure 6, reference 180, page 4, paragraph [0041], lines 1-6).

However, H. Gray does not expressly disclose a user initiated request from a user of the apparatus for a location of a wireless local area network (WLAN). In an analogous art, Shaheen et al. discloses a user initiated request from a user of the apparatus for a location of a wireless local area network (WLAN)(col. 2, lines 32-35).

One skilled in the art would have recognized the user initiated request for a location of a wireless local area network (WLAN), and would have applied Shaheen et al.'s initiates acquisition of the locations of the preferred WLANs in H. Gray's request positions and/or direction to one or more nearby WLANs. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to use Shaheen et al.'s method and apparatus for handoff between a wireless local area network (WLAN) and a universal mobile telecommunication system (UMTS) with the motivation being to provide the locations of the preferred WLANs (col. 2, lines 34-35).

Furthermore, H. Gray in view of Shaheen et al. does not expressly disclose wherein a user is provided, responsive to receiving over said wireless network said location of said wireless local area network (WLAN), with a menu option selection for selecting a distance or distance range from a wireless service area of the wireless network to said location of said wireless local area network (WLAN). In an analogous art, Hussa discloses wherein a user is provided, responsive to receiving over said wireless network said location of said wireless local area network (WLAN), with a menu option selection for selecting a distance or distance range from a wireless service area of the wireless network to said location of said wireless local area network (WLAN)(In network-based positioning, the terminal sends a service request to the network. In response, the network computes the location estimate of the terminal and sends it to the terminal. At the terminal, the access point set is selected based on the WLAN coordinates, and these coordinates may be downloaded from the network or the network sent the terminal the coordinates the access points within a given maximum distance from the terminal, paragraph [0038], lines 3-13), and a terminal includes a display unit 512 for displaying the locations of the access points for the user (menu option selection means), paragraph [0042], lines 21-23).

One skilled in the art would have recognized the wherein a user is provided, responsive to receiving over said wireless network said location of said wireless local area network (WLAN), with a menu option selection for selecting a distance or distance range from a wireless service area of the wireless network to said location of said wireless local area network (WLAN), and would have applied Hussa's service request in

H. Gray's request positions and/or direction to one or more nearby WLANs. Therefore, it

would have been obvious to one of ordinary skill in the art at the time of the invention, to

use Hussa's access point service for mobile users in H. Gray's method and system of

informing WAN user of nearby WLAN access point with the motivation being selected

the access point set based on the WLAN coordinates paragraph [0038], lines 8-9).

For claim 8, H. Gray discloses further comprising wireless baseband circuitry and

WLAN baseband circuitry (page 4, paragraph [0041], lines 7-26).

For claim 10, H. Gray discloses wherein said controller processes said receiving

of said location of said wireless local area network WLAN by displaying said location as

one of a street address, map coordinates, longitude and latitude, and global positioning

coordinates (page 5, paragraph [0043], lines 2-8).

For claim 11, H. Gray discloses wherein said wireless transceiver and said

controller are within a cellular communication device (page 4, paragraph [0041], lines 7-

13).

For claim 12, H. Gray discloses wherein said wireless network is a cellular

telephone network (figure1, reference 10, page 2, paragraph [0020], line 1).

For claims 13, H. Gray discloses method and system of informing WAN user of

nearby WLAN access point, comprising:

a wireless network for providing wireless communication services over a wireless

service area (page 2, paragraph [0023]), and

a mobile device for sending a user request from said wireless service area

across said wireless network for a location of a wireless local area network WLAN

(figure 5, reference steps 1-3, page 4, paragraph [0035], lines 2-4), paragraph [0036], lines 2-4).

However, H. Gray does not expressly disclose a user initiated request for a location of a wireless local area network (WLAN). In an analogous art, Shaheen et al. discloses a user initiated request for a location of a wireless local area network (WLAN)(col. 2, lines 32-35).

One skilled in the art would have recognized the user initiated request for a location of a wireless local area network (WLAN), and would have applied Shaheen et al.'s initiates acquisition of the locations of the preferred WLANs in H. Gray's request positions and/or direction to one or more nearby WLANs. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to use Shaheen et al.'s method and apparatus for handoff between a wireless local area network (WLAN) and a universal mobile telecommunication system (UMTS) with the motivation being to provide the locations of the preferred WLANs (col. 2, lines 34-35).

Furthermore, H. Gray in view of Shaheen et al. does not expressly disclose providing, responsive to said mobile device receiving the location of the wireless local area network, a user with a menu option selection in a mobile device for selecting a distance or distance range from a wireless service area of the wireless network to said location of said wireless local area network (WLAN). In an analogous art, Hussa discloses providing, responsive to said mobile device receiving the location of the wireless local area network, a user with a menu option selection in a mobile device for selecting a distance or distance range from a wireless service area of the wireless

network to said location of said wireless local area network (WLAN)(In network-based

positioning, the terminal sends a service request to the network. In response, the

network computes the location estimate of the terminal and sends it to the terminal. At

the terminal, the access point set is selected based on the WLAN coordinates, and

these coordinates may be downloaded from the network or the network sent the

terminal the coordinates the access points within a given maximum distance from the

terminal, paragraph [0038], lines 3-13), and a terminal includes a display unit 512 for

displaying the locations of the access points for the user (menu option selection

means), paragraph [0042], lines 21-23).

One skilled in the art would have recognized the providing, responsive to said

mobile device receiving the location of the wireless local area network, a user with a

menu option selection in a mobile device for selecting a distance or distance range from

a wireless service area of the wireless network to said location of said wireless local

area network (WLAN), and would have applied Hussa's service request in H. Gray's

request positions and/or direction to one or more nearby WLANs. Therefore, it would

have been obvious to one of ordinary skill in the art at the time of the invention, to use

Hussa's access point service for mobile users in H. Gray's method and system of

informing WAN user of nearby WLAN access point with the motivation being selected

the access point set based on the WLAN coordinates paragraph [0038], lines 8-9).

For claim 14, H. Gray discloses wherein said location of said wireless local area

network WLAN is based on a location of said wireless service area (page 4, paragraph

[0037], lines 1-16).

For claim 15, H. Gray discloses wherein said location of said WLAN comprises one of a street address, map coordinates, latitude and longitude, and global positioning coordinates (page 5, paragraph [0043], lines 2-8).

For claim 16, H. Gray discloses wherein said wireless network comprises a cellular telephone network (figure1, reference 10, page 2, paragraph [0020], line 1).

For claim 17, H. Gray discloses wherein said mobile device comprises a cellular telephone (page 4, paragraph [0040], line 17).

For claim 18, H. Gray discloses wherein said mobile device comprises processing for receiving said location of said wireless local area network WLAN (figure 5, reference step 6, page 4, paragraph [0039], lines 1-4).

For claim 19, H. Gray in view of Shaheen et al. does not expressly disclose wherein the user initiated request includes a user-selected distance or distance range from a wireless service area of the wireless network to said location of said wireless local area network WLAN. In an analogous art, Hussa discloses wherein the request includes a user-selected distance or distance range from a wireless service area of the wireless network to said location of said wireless local area network WLAN (the selection criteria may be fixed or the user may give them in connection with the service request. The user may, for example, request the access points within a certain distance from his or her current location. The user may also indicate a route and request the access points that are located within a certain distance from the route (selecting a distance or distance range from a wireless service area of the wireless network to said

location of said wireless local area network (WLAN) means), paragraph [0032], lines 1-
6).

One skilled in the art would have recognized the wherein the request includes a
user-selected distance or distance range from a wireless service area of the wireless
network to said location of said wireless local area network WLAN, and would have
applied Hussa's service request in H. Gray's WAN user 52 requesting positions and/or
directions to one or more nearby WLAN access points 24. Therefore, it would have
been obvious to one of ordinary skill in the art at the time of the invention, to use
Hussa's access point service for mobile users in H. Gray's method and system of
informing WAN user of nearby WLAN access point with the motivation being to provide
the user request the access points within a certain distance from his or her current
location (page 3, paragraph [0032], lines 1-4).

Conclusion

4.   The prior art made of record and not relied upon is considered pertinent to
applicant's disclosure.

5.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time
policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE
MONTHS from the mailing date of this action. In the event a first reply is filed within
TWO MONTHS of the mailing date of this final action and the advisory action is not
mailed until after the end of the THREE-MONTH shortened statutory period, then the
shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

6.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to TOAN D. NGUYEN whose telephone number is

(571)272-3153. The examiner can normally be reached on M-F (7:00AM-4:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Hassan Kizou can be reached on 571-272-3088. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. D. N./
Examiner, Art Unit 2472

/Hassan Kizou/
Supervisory Patent Examiner, Art Unit 2472